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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,235	04/12/2000	Thomas Mark Levergood	1984.1001-004	6069

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EXAMINER
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WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/22/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/548,235

Applicant(s)

LEVERGOOD ET AL.

Examiner

Patrice Winder

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 22.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Oath/Declaration***

1. This application presents a claim for subject matter not originally claimed or embraced in the statement of the invention. The "method for charging for advertising on the web" and "the method for measuring the effectiveness of advertising" not claimed in the parent application. A supplemental oath or declaration is required under 37 CFR 1.67. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not provided a detailed disclosure of "charging for advertising based on link traversals to the page". The examiner is aware of page 14, line 24 - page 15, line 6 of the disclosure. If there is further detail to applicant's disclosure please indicate the corresponding areas of the disclosure.

4. Claims 4-5 and 9-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as

to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant has not provided a detailed disclosure of "measuring the number of sales or transactions resulting from link traversals". The examiner is aware of page 14, line 24 - page 15, line 6 of the disclosure. If there is further detail to applicant's disclosure please indicate the corresponding areas of the disclosure.

5. It is generally understood that the state of the art at the time of the invention as understood by the inventor can be determined by the degree of detail in the disclosure and that which is left for one of ordinary skill in the art to perform is presumed to be within the skill in the art to perform. As applicant has supplied no detail enabled of this alleged nonobvious process by which to "charge for advertising based on link traversals to the page" and "measure the number of sales or transactions resulting from link traversals". Therefore, it is presumed to be within the skill of the art (*In re Fox 176 USPQ 340*).

#### ***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code § 103 not included in this action can be found in a prior Office action.

7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catledge et al., Characterizing Browsing Strategies in the World-Wide Web (hereafter referred to as Catledge) in view of Bob Novick, The Clickstream (hereafter referred to as Novick).

Regarding claim 6, Catledge taught a method for characterizing browsing on the web (abstract), comprising:

tracking access history, including a link sequence through which a document is accessed(log files of World-Wide Web accesses, page 4);

determining, based on the access history, link traversals from a first document to a second document (sequences of accesses or paths);

determining a number of such determined link traversals leading from the first document to the second document (frequency determination by site analysis module, page 5). Catledge does not specifically teach charging for advertising based on the number of link traversals to the second document. However, Novick taught charging for advertising based on the number of link traversals to the second document (paths to end sites, paragraphs 1, 4).

Regarding dependent claim 7, Catledge taught a link traversal is determined responsive to two entries in the access history, a first entry corresponding to a request from a given user for the first document and a second entry corresponding to a request from the given user for the second document (log file of World-Wide Web accesses, page 4).

Regarding dependent claim 8, Novick taught the first document is an advertising page and the second document is a product page (paragraphs 1, 3, 4).

Regarding dependent claim 9, Catledge taught counting the frequency resulting from a traversed path which includes the specified page (site analysis module, page 5). Catledge does not specifically teach the frequency is number of sales, the specified

page is the advertising page and charging for advertising is based on the frequency. However, Novick taught the number of sales (clicks at storefronts translate to sales, paragraph 1), the specified page is the advertising page (paragraph 3) and charging for advertising is based on the number of sales (paragraph 4).

The language of claims 10-11 is substantially the same as dependent claim 9. Therefore, claims 10-11 are rejected on the same rationale as claim 9.

Regarding dependent claim 12, Catledge taught filtering transaction logs from at least one server for a particular user to produce the access history (site analysis module, page 5).

The language of claims 1-5 is substantially the same as claims 6-12, above. Therefore, claims 1-5 are rejected on the same rationale as claims 6-12.

As to claims 1-12, it would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Novick's charging for advertising in Catledge's system for characterizing browsing would have improved system efficiency. The motivation would have been to use the information determined from characterizing user browsing sessions and utilize the established advertising model of charging rates based on cost per thousand.

### ***Response to Arguments***

8. Applicant's arguments filed July 31, 2003 have been fully considered but they are not persuasive.

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9. Applicant argues – “The Examiner has given no indication as to what part of ‘charging for advertising based on the number of link transversals to the page’ is not sufficiently clear to enable one of ordinary skill in the art to practice the invention. Definition for ‘charging’ given in Webster’s New Riverside Dictionary is ‘4. To ask a price.’ Thus, according to the invention one asks a price for advertising ‘based on the link traversals to the page.’ Applicant submits that this phrase is enabling to even those with minimum skill in the art.”

a. Applicant’s “charging” action can not be simultaneously known to one with “minimum skill in the art” and provide enabling disclosure to support applicant’s claim of novelty.

10. Applicant argues – “As described at page 14, line 24 of the specification, in an embodiment of the invention the access history is evaluated to determine which links have been traversed leading to the purchase of a product. Applicant’s are at a loss to determine how the step of ‘measuring the number sales (or transactions) resulting from link transversals’ could be enabled more fully.”

b. Applicant’s “measuring” can not be simultaneously well known enough to warrant a less than detailed disclosure, while providing enabling disclosure to support applicant’s claim of novelty.

11. Applicant argues – “First, there is no teaching or suggestion within the references themselves or within the knowledge generally available to those of skill in the art that would have led one of ordinary skill in the art to make the combination suggested by the Examiner.”

c. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Catledge taught a method and apparatus of determining the clickstream. Novick taught the using the clickstream used to determine "cost per thousand clicks", i.e. sales per clicks.

12. Applicant argues – "Second, even when combined, Catledge and Dedrick do not teach or suggest every element of the claimed invention." (The Examiner assumes that applicant means Novick as is consistent with the rest of the response.)

d. Novick taught "costs per thousand clicks" on pages 1-2. Using the same Webster's New Riverside University Dictionary, cost has the equivalent synonyms "charge, price, tab" and the meaning the amount paid or to be paid for a purchase. The context of Novick's article, "The Clickstream" is advertisers developing ways to lure customers using the "clickstream", which measure cyberspaces influence.



***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is (703) 305-3938. The examiner can normally be reached on Monday-Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam, can be reached on (703) 308-6662. The fax phone number for this Group is official (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

  
**PATRICE WINDER**  
**PRIMARY EXAMINER**